



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/274,172	11/19/97	LI	129249-2

THOMAS R TREMPUS
ALUMINUM COMPANY OF AMERICA
ALCOA TECHNICAL CENTER
100 TECHNICAL DRIVE
ALCOA CENTER PA 15069-0001

0M11/1005

EXAMINER

DENTER, C

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 10/05/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/974,179

Applicant(s)

Li et al.

Examiner

Clark F. Dexter

Group Art Unit

3724



☒ Responsive to communication(s) filed on Jul 20, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-45 is/are pending in the application.

Of the above, claim(s) 6-9 and 18-45 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-5 and 10-17 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3724

DETAILED ACTION

Election/Restriction

1. Applicant's election of Group I, and the species corresponding to claims 10-17 within Group I in the response filed July 20, 1998 (paper no. 4) is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election **without** traverse (MPEP § 818.03(a)). Further, claims 1-4 have been included in the examination as reading on the elected species. Claims 6-9 and 18-45 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to non-elected species and inventions.

Information Disclosure Statement

2. The information disclosure statement filed January 20, 1998 has been received and the references listed thereon have been considered.

Drawings

3. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

Art Unit: 3724

Specification

4. The disclosure is objected to because of the following informalities: On page 6, line 9, it seems that "4-7" should read -- 4-8 -- or the like.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. Claims 1-5 and 10-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the entire claim is vague and indefinite since there is only one step (i.e., cutting) that has been set forth, and thus insufficient steps have been set forth to provide the recited result "substantially eliminate the formation of aluminum slivers"; in line 2, "cutting blade clearance" is vague and indefinite, particularly as to what it pertains since the claim does not set forth the type of device performing the cutting step.

In claim 3, line 1, "the cutting blade" lacks antecedent basis.

In claim 5, line 1, "the cutting blade" lacks antecedent basis.

In claim 10, line 2, "an aluminum sheet" is vague and indefinite as to whether it refers to that in the preamble or to another such sheet; in lines 6-7, the "recovering" step is vague and indefinite since it is not clear how the step is performed to provide the result "with substantially no slivers".

Art Unit: 3724

In claim 11, line 1, [✓]the step of “securing” is vague and indefinite as to whether it refers to that set forth in claim 10 or to another such step.

In claim 12, line 1, [✓]the step of “securing” is vague and indefinite as to whether it refers to that set forth in claim 10 or to another such step.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 10, 11 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Ishibashi.

Ishibashi discloses a cutting apparatus on which every step of the claimed method is performed as best understood from the claims.

Allowable Subject Matter

8. Claims 2-5 and 12-16 appear that they would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Art Unit: 3724

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703)308-2187.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.

Communications via Internet e-mail regarding this application, other than those under 35 USC 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [rinaldi.rada@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 USC 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.



Clark F. Dexter
Primary Examiner
Art Unit 3724

cf
September 28, 1998